



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/732,985	12/11/2003	Donald E. Brodnick	039199-9544-00	8570

7590 11/28/2006

JOSEPH D. KUBORN
ANDRUS, SCEALES, STARKE & SAWALL
100 EAST WISCONSIN AVENUE
SUITE 1100
MILWAUKEE, WI 53202

EXAMINER

LIN, JACK

ART UNIT	PAPER NUMBER
----------	--------------

3768

DATE MAILED: 11/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/732,985

Applicant(s)

BRODNICK ET AL.

Examiner

Jack Lin

Art Unit

3768

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-26 and 28-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-26 and 28-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to applicant's amendments received on November 3, 2006.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 1, 2, 4-15, and 42-46 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1, 2, and 4-15, the preamble of claim 1 recites a method of acquiring pulse oximetry and electrocardiogram signals, however, the claimed elements are directed to configuring a transducer and attaching the transducer to a patient which do not result in acquiring pulse oximetry and electrocardiogram signals. That is, although the claim sets forth that the signal transducer is "configured to" acquire data, no positively recited steps of acquiring are set forth. Additionally, claims 2 and 4-15 do not further limit the method of configuring a transducer and attaching the transducer to a patient as they further limit a method of acquiring pulse oximetry and electrocardiogram signals. However, as noted above, the base claim does not include these steps.

Art Unit: 3768

Claim 42 recites the limitations "the pulse oximetry signal" on page 10, lines 1-2 and "the reference electrocardiogram" on page 10, lines 3-4. There are insufficient antecedent bases for these limitations in the claim since no signals have been acquired in the method steps.

Claim 46 recites the limitations "the pulse oximetry signal" on page 11, lines 3-4, "the reference electrocardiogram signal" on page 11, lines 4-5, and "the at least two non-reference electrocardiogram signals". There are insufficient antecedent bases for these limitations in the claim since no signals have been acquired in the method steps.

Claim Rejections - 35 USC § 102

5. The rejection of claims 1-2, 4-9, 13-18, 20, 22-23, 28-33, 35, 37-38 and 42-46 under 35 USC 102(e) as being anticipated by Mills '205 (US Patent Application Publication 2002/0188205) is hereby maintained for the reasons of record.

6. The rejections of claims 1, 10, and 13 under 35 USC 102(e) as being anticipated by Mills '772 (US Patent Application Publication 2003/0109772) is hereby maintained for the reasons of record.

Claim Rejections - 35 USC § 103

7. The rejection of claims 10, 24, and 39 under 35 USC 103(a) as being unpatentable over Mills '205 as applied to claims 1, 6, and 28, and further in view of Rodiera Olive (US Patent 5,957,860 – cited by applicant) is hereby maintained for the reasons of record.

Art Unit: 3768

8. The rejection of claims 11, 12, 25, 26, 40, and 41 under 35 USC 103(a) as being unpatentable over Mills '205 in view of Rodiera Olive as applied to claims 10, 24, and 39, and further in view of Niwa (US Patent 5,025,791) is hereby maintained for the reasons of record.

9. The rejection of claims 19, 21, 34, and 36 under 35 USC 103(a) as being unpatentable over Mills '205 as applied to claims 16 and 28, and further in view of Merchant et al. (US Patent 6,023,541) is hereby maintained for the reasons of record.

Response to Arguments

10. Regarding the rejection of claims 1, 2, 4-15, and 42-46 under 35 U.S.C. § 101 as being directed to non-statutory subject matter, applicant's arguments have been considered but are moot in view of the amendments.

11. Regarding the rejection of claims 1-2, 4-9, 13-18, 20, 22-23, 28-33, 35, 37-38 and 42-46 under 35 USC 102(e) as being anticipated by Mills '205, applicant's arguments have been fully considered but they are not persuasive. Applicant argues that while Mills '205 discloses a probe comprising an emitter, detector, and ECG electrode, the ECG electrode is utilized to collect non-reference ECG signals only. Applicant further states the ECG electrode in the claimed invention is configured to collect either a reference or non-reference ECG signal. The argument is not persuasive for two reasons. First, the claim as written does not place a limitation on the ECG electrode to be capable of acquiring both a reference or non-reference ECG signal. As claimed, the limitation on the ECG electrode is only "wherein the acquired electrocardiogram signal is either one of a reference electrocardiogram signal or a non-reference electrocardiogram signal" (claim 1). As such, an ECG electrode configured to acquire either a reference or non-reference

Art Unit: 3768

ECG signal meets the claim limitation. Second, as stated in the prior office action, "Mills '205 teaches generating a diagnostic-quality ECG by attaching multiple probes (paragraph 129) which inherently involves acquiring a reference electrocardiogram signal and non-reference electrocardiogram signals." This disclosure by Mills '205 teaches that the probes are configured to collect either a reference or non-reference ECG signals. Therefore, the rejection is hereby maintained.

12. Regarding the rejections of claims 1, 10, and 13 under 35 USC 102(e) as being anticipated by Mills '772, applicant's arguments have been fully considered but they are not persuasive. Applicant argues that Mills '772 discloses the same invention as Mills '205 and for the same reasons discussed, does not anticipate the claims. This argument is addressed by the discussion above and applies to Mills '772 since Mills '772 and Mills '205 have the same disclosure. Therefore, the rejection is hereby maintained.

13. Regarding the rejection of claims 10, 24, and 39 under 35 USC 103(a) as being unpatentable over Mills '205 as applied to claims 1, 6, and 28, and further in view of Rodiera Olive, applicant's arguments have been fully considered but they are not persuasive. Applicant argues that claims 10, 24, and 39 traverse the rejection since they depend from claims 1, 16, and 28. This argument is addressed by the discussion above of claims 1, 16, and 28. Therefore, the rejection is hereby maintained.

14. Regarding the rejection of claims 11, 12, 25, 26, 40, and 41 under 35 USC 103(a) as being unpatentable over Mills '205 in view of Rodiera Olive as applied to claims 10, 24, and 39, and further in view of Niwa, applicant's arguments have been fully considered but they are not persuasive. Applicant argues that claims 11, 12, 25, 26, 40, and 41 traverse the rejection since

Art Unit: 3768

they depend from claims 1, 16, and 28. This argument is addressed by the discussion above of claims 1, 16, and 28. Therefore, the rejection is hereby maintained.

15. Regarding the rejection of claims 19, 21, 34, and 36 under 35 USC 103(a) as being unpatentable over Mills '205 as applied to claims 16 and 28, and further in view of Merchant et al., applicant's arguments have been fully considered but they are not persuasive. Applicant argues that claims 19, 21, 34, and 36 traverse the rejection since they depend from claims 16 and 28. This argument is addressed by the discussion above of claims 16 and 28. Therefore, the rejection is hereby maintained.

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Art Unit: 3768

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jack Lin whose telephone number is (571) 272-7694. The examiner can normally be reached on Monday-Friday, 8:00 a.m. - 4:30 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eleni Mantis-Mercader can be reached on (571) 272-4740. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JL
Art Unit 3768

ERIC F. WINAKUR
PRIMARY EXAMINER

